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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,771	10/06/2000	Andrew F. Silverman	3499-86	3225
27383	7590	09/29/2004	EXAMINER	
CLIFFORD CHANCE US LLP			PATEL, JAGDISH	
31 WEST 52ND STREET			ART UNIT	
NEW YORK, NY 10019-6131			PAPER NUMBER	

3624

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,771

Applicant(s)

SILVERMAN ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 7-18, 28-29 and 30 are, respectively drawn to a method, a computerized system and an apparatus for processing an order for a security traded on a floor of a trading exchange.

Claims recite feature specific to trading aspect of a security such as an order message comprising a request to trade the security on a trading exchange to a computer server. The claims further recites attributes specific to the order message which include trading related parameters pertaining to a trading order.

II. Claims 19-23 are, drawn to a method for processing a look request for a security traded on a floor of a trading exchange.

Claims recite feature specific to a look request message of for a security such as active duration of the look request (amount of time that an accepted look request will live before it is passively rejected).

III. claims 24-26 are, drawn to a method for processing an order for a security trading which is implemented on a

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handheld computing device. The method recites specific steps that require interaction of an operator of the handheld computing device such as the order reply message indicating whether the operator of the handheld computing device accepts or rejects the order.

IV. Claim 27 is, drawn to a method for communication with a handheld computing device for processing a look request for a security. The method recites specific steps that require interaction of an operator of the handheld computing device such as the look reply message indicating whether the operator of the handheld computing device accepts or rejects the look request.

V. Claims 31-32 are directed to an apparatus, which causes a handheld computing device to execute a predefined operational protocol in association with a computer server to which it interfaces for processing an order message.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-V are related as product and process of use.

The inventions can be shown to be distinct if either or both of

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the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the apparatus (system) in group I (28-29 and 30) can be used in a materially different process than that recited in method claims of inventions II-IV such as processing a look request for a security traded on a floor of a trading exchange recited in invention II, a method of processing an order (or look request) which is implemented on a handheld computing device and that recited in method claims of inventions III and IV which require interaction of an operator of the handheld computing device.

Inventions I, II, III and IV are also are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the subcombination as claimed in each of inventions I-IV does not require the particulars of the subcombination as claimed in other inventions. Each subcombination has separate utility from the other

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subcombination, such as invention I has the utility of processing an order for a security traded on a floor of a trading exchange, invention II has the utility of processing a look request for a security traded on a floor of a trading exchange, invention III has the utility of processing an order for a security trading which is implemented on a handheld computing device, and invention IV has the utility of processing a look request for a security in communication with a handheld computing device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and the search required for each invention is not required for the other inventions, restriction for examination purposes as indicated is proper.

4. A telephone call was made to James V. Mahon (Reg. 41,966) on September 26, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in

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compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

9/24/04